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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/768,476	01/24/2001	Bruce A. Fogelson	6040/80679	1531

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EXAMINER

MCALLISTER, STEVEN B

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/768,476

Applicant(s)

FOGELSON, BRUCE A.

Examiner

Steven B. McAllister

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

### A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/3/2005 has been entered.

#### ***Note Regarding Examination***

It is noted that as required by MPEP 2144.03(C), the "notoriously old and well known" or "old and well known" statements made regarding certain subject matter in the Office Action of 11/18/2004 are interpreted as admitted prior art since such statements must be traversed in the subsequent response or be deemed admitted.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 13 and 25 recite "contract support" services, but it is unclear what this means.

Claims 2, 14 and 26 recite "post-sale", but is unclear when the point of sale is intended. In examining the claims, it was assumed to be the time of contracting and provision of some consideration by the buyer.

Claims 11, 23, and 35 recite that the step of collecting the fee or commission based on the views and selections of the customer comprises "collecting up-front access, semi-custom web design, and data service fees or commissions". However, as understood by the examiner, the specification describes these as additional fees that can be charged in addition to the "fee or commission based upon the products viewed". In examining the claims, it is interpreted that the claimed charges are further collected in addition to the commission based on customer views and selections.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-36 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-43 of

compending Application No. 09/483,579. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of '579 show all elements of the claims 1, 13, and 25 (including providing a variety of forms to be filled out since the presentation and selection of options via html pages comprises providing forms to be filled out; contract support services since providing the options inherently includes providing the services required to install them in support of the contract; and incorporating the selected options, content of the filled forms and support services into a modification of the contract).

Alternatively, the claims of '579 show all but providing support services and incorporating support services. However, it is notoriously old and well known in the art to do so. It would have been obvious to one of ordinary skill in the art to modify the method of '579 by providing services and incorporating them in a contract change once they are selected in order to automate the tracking of the provision of the services.

As to claims 3-5, 7, 8, 15-17, 19, 20, 26-29, 31, 32, and 35, it is noted that all elements are shown except the additional elements in the enumerated claims. However, to provide those elements is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to further modify the method of '579 by providing the recited elements in order to provide a more full featured system.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-6, 11-18, and 23-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fino et al (5,991,769) in view of Downs et al (6,226,618).

Regarding claims 1, 13 and 25, Fino et al show the customer and builder entering into a contract; providing an interface for selection of options for installation under the pre-existing contract; receiving from the customer through the interface a selection of an option via its selection on a provided electronic form by the contractor (note that the figures show browsing through options and selecting the option of a fireplace while an approved contract exists) and the selection of contract support services (such as examination, comparing and selection of different types of loans). It further shows incorporating the options, content and services into a contract change. It inherently shows collecting by the contractor from the customer a fee based upon the received selection made by the customer comprising the cost of the new option. Fino et al also show providing a second interface for associated with the first interface for entry of information related to the customer by the builder. Fino et al do not show that providing the first and second interfaces comprises providing a first website and second website by a third party; or that receiving from the customer through the interface comprises receiving the selections via the first website. Downs et al show providing a selection interface via a third part website; and receiving customer selections through the website. It would have been obvious to one of ordinary skill in the art to modify the

method of Fino et al by providing a first website as an interface and receiving the inputs via the website in order to allow selection of options by the customers outside office hours.

As to claims 2, 14, and 26, Fino et al show forms providing product information, contract, financing and closing and post-sale forms and information (since it shows forms showing move in costs (Fig. 4C, e.g.) it shows forms and information relating to closing).

As to claims 3, 15, and 27, Fino et al in view of Downs et al show providing purchase information and pre-purchase information. It does not show providing the other information types. However, it is notoriously old and well known in the art to provide such information. It would have been obvious to one of ordinary skill in the art to do so in order to provide useful information to clients ( and therefore attract more users to the site) and to collect additional revenue via affiliate programs with service providers.

As to claims 4, 5, 15, 16, 28, and 29, Fino et al in view of Downs et al show all elements of the claims except purchasing extras with an online deposit system. However, this is notoriously old and well known in the art (and interpreted as admitted prior art). (For instance, Dell computer and FTD provide for buying extras comprising options or upgrades and for paying for them via an electronic deposit system). It would have been obvious to one of ordinary skill in the art to further modify the method

Fino et al by purchasing extras using an online deposit system in order to quickly and conveniently secure their purchase (via Visa or Mastercard, for example).

As to claims 11, 23, and 35, Fino et al in view of Downs et al show all elements except charging up-front access, web design fees and data service fees to the builder and advertisers. However, it is notoriously old and well known in the art (and interpreted as admitted prior art) to do so. It would have been obvious to one of ordinary skill in the art to charge such fees in order to recover costs of resources used by the builders and advertisers.

As to claims 12, 24, and 36, Fino et al in view of Downs et al show all elements except advertising products on the website. However, it is notoriously old and well known in the art (and interpreted as admitted prior art) to allow advertising of products or services on a website. It would have been obvious to one of ordinary skill in the art to do so in order to get additional revenue from advertising.

Claims 7-10, 19-22 and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fino et al in view of Downs et al as applied to claims 1, 13 and 25 above, and further in view of by "RFP Marketing Opportunities Abound At: 'Design Your Dream House'" (RFP).

Fino et al in view of Downs et al show all elements of the claims except collecting data concerning buying trends. It would have been obvious to one of ordinary skill in the art to further modify the method of Fino et al by collecting such data in order to know



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which options are more popular and in order to have aggregate data to sell to other entities.

As to claims 8, 20, and 32, Fino et al in view of Downs et al show all elements of the claim except allowing manufacturers, sub-contractors, and vendors to view potential orders, groups of orders, and products viewed (and ordered) by customers in order to provide bids. RFP shows this element. It would have been obvious to one of ordinary skill in the arts to further modify the method of Fino et al by providing the information to the recited actors in order to better coordinate.

As to claims 9, 10, 21, 22, 33 and 34, Fino et al in view of Downs et al show all elements except providing web and communications tools to the builder, sub-contractors and suppliers, comprising at least messaging. RFP shows providing such communication (e.g., 2d full paragraph of pg. 3). It would have been obvious to one of ordinary skill in the art to further modify the method of Fino et al by providing communications comprising messaging in order to better coordinate.

### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is (703) 308-7052. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P. Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Steven B. McAllister

**STEVE B. MCALLISTER**  
**PRIMARY EXAMINER**